



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,598	12/01/2003	Francis Blanche	3806.0050-02	8180

22852 7590 06/30/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

MOORE, WILLIAM W

ART UNIT PAPER NUMBER

1656

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/724,598

Applicant(s)

BLANCHE ET AL.

Examiner

William W. Moore

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2006 and 01 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 58-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 07/916,151.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20031201 &amp; 20041108</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION***Priority*

Applicant's claim in the Declaration of Inventorship and in the first page of the specification as amended on 8 November 2004 to priority under 35 U.S.C. § 119 of the 31 January 1990 filing date of the French patent application No. 90 011377, and its successor International patent application PCT/FR91/00054 filed 31 January 1991, is hereby acknowledged. Applicant's claim to priority is perfected by a claim to domestic priority in the Declaration of Inventorship and in the first page of the specification as amended on 8 November 2004 to the national stage filing of US application 07/916,151 and its successor application 08/426,630, now issued as US Patent No. 6,656,709, of which the instant application is a continuation.

*Information Disclosure Statement*

Applicant's Information Disclosure Statements [IDS] filed with the application on 1 December 2003 and on 8 November 2004 are hereby acknowledged. Executed copies of the Forms PTO-1449 accompanying both IDS are provided with this communication.

*Preliminary Amendments and Abstract*

Applicant's Preliminary Amendment filed with the application on 8 November 2004 has been entered, canceling claims 1-57 and adding the new claims 58-116 which correspond to claims 1-58 of the commonly assigned US Patent No. 6,656,709 which issued on the identical disclosure of the parent application. The preliminary amendment revising the continuing data at page 1 of the specification filed 8 November 2004 has also been entered and the Abstract filed 8 November 2004 is approved.

*Specification*

Compliance with 37 CFR § 1.821 is required in response to this Office action. Claims 58, 62, 67, 72, 77, 82, 87, 92, 97, and 102 do not have designations describing

Art Unit: 1656

their subject matters according to the requirements of 37 CFR § 1.821 for a Sequence Disclosure. Even if the nucleic acid sequence of the genes sequences were set forth in the claims, recitations of a nucleotide or amino acid sequence positions must also include a statement of the designation, "**SEQ ID NO:n**", where "n" is an integer corresponding to the Sequence Disclosure, e.g., SEQ ID NO:3 for the *cobA* gene, SEQ ID NO:4 for the COBA protein, SEQ ID NO:5 for the *cobB* gene, SEQ ID NO:6 for the COBB protein, etc.

37 CFR § 1.821 also requires that sequence identifiers accompany descriptions of defined nucleotide and amino acid sequences in the specification, e.g., pages 10, 18, 36, 46, 51, 57, 76-79, 81, 85, 87, 89, 92-102, 107, 111, 113, 114, 116-120, 122, 126-128, 132, 135, 136, 141, 142, 146-153, and 155-160, with a designation properly stated as "**SEQ ID NO:n**". See 37 CFR §§ 1.821(b), (c) and (d).

#### *Claim Objections*

Claims 58, 62, 67, 72, 77, 82, 87, 92, 97, and 102 are objected to because of the following informalities: The claims recite the designations of particular genes disclosed in the specification but fail to provide the proper format for such designation, i.e., the use of italics in the three letter, lower case, portion thereof, e.g., "*cobA*" instead of *cobA*". Appropriate correction is required.

#### *Claim Warning – Duplicate Claims*

Applicant is advised that should claims 77-81 be found allowable, claims 82-86 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Here, the duplication arises because claim 82 erroneously

Art Unit: 1656

refers back to claim 77 instead of claim 67. See corresponding claim 25 in US Patent No. 6,656,709 which does not refer back to claim 20 but refers instead back to claim 10.

#### *Absence of a Requirement for Restriction*

Because the methods recited in the new claims 58-115 herein are essentially identical to the methods described in the patented claims 1-58 that issued on the parent application 08/426,630, the same subject matters have already been examined and a requirement for restriction among the new claims 58-115 herein is therefore improper.

#### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). A statutory type (35 U.S.C. § 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. § 101.

Claims 58-116 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-58 of prior U.S. Patent No. 6,656,709. Except for the error in claim 82 noted above, claims 58-116 herein are essentially identical to the patented claims 1-58. This is a statutory double patenting rejection because there is no difference between the patented claims and the claims pending herein.

#### *Conclusion*


While subject to the objections above and the rejection above for double patenting, the claims 58-116 are allowable over the prior art made of record herein.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1656

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William W. Moore whose telephone number is 571.272.0933 and whose FAX number is 571.273.0933. The examiner can normally be reached Monday through Friday between 9:00AM and 5:30PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisory Primary Examiner, Dr. Kathleen Kerr, can be reached at 571.272.0931. The official FAX number for all communications for the organization where this application or proceeding is assigned is 571.273.8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571.272.1600.

William W. Moore  
26 June 2006

  
NASHAAT T. NASHED PHD.  
PRIMARY EXAMINER